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Application No. 10/031,142
Reply to Office Action of July 3, 2006

REMARKS

Presently, claims 117-199 are pending in the application. Claims 117, 121, 141, 142, 145, 149, 153, 165, 169, 172, 174, 175, 178, 182, 192, 196, and 197 have been amended. Support for the features recited in the amended independent claims 117, 121, 141, 142, 145, 149, 153, 165, 172, 174, 175, 178, 182, 192, 196, and 197 may be found, for example, at page 12, lines 14 – 35 and at page 6, lines 12 – 16 of the specification. Claim 169 has been amended to correct a formal error noted by Applicants. Accordingly, no new matter has been added to the application by the foregoing amendments

Claim Rejections – 35 U.S.C. §102(b)

The Examiner has rejected claims 117-119, 121-124, 127-129, 131-133, 135-138, 143-144, 146-150, 153-156, 159-160, 162-164 and 196 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,652,615 to Bryant ("Bryant"). The Examiner contends that Bryant teaches all elements of these claims. Applicants respectfully traverse this rejection.

Bryant discloses a system for broadcasting composite programs to particular audiences. In the composite program, the base program content segments are decoupled from the program fill segments. In the program fill segments, multiple targeted advertisements are inserted, with each advertisement in a fill segment being selected for a different targeted subscriber group.

For a rejection under 35 U.S.C. §102(b) to be proper, a reference must disclose, either explicitly or inherently, each and every element of the claimed invention. Applicants respectfully submit that Bryant does not disclose each and every element recited in independent claim 117.

Independent claim 117 recites (with emphasis added):

A method for presenting targeted advertisements in a telecom system, the method comprising:

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forming a group for the reception of signals for the telecom system;

forming a plurality of subgroups for the group;

assigning a subgroup address to each subgroup;

receiving a program stream;

selecting one or more targeted advertisements for a first subgroup;

assigning an advertisement identifier to each of the targeted advertisements;

creating a relationship between the subgroup address and the one or more advertising identifiers; and

transmitting the program stream and the targeted advertisements selected for the first subgroup to the first subgroup, wherein the first subgroup does not receive targeted advertisements corresponding to any other subgroup.

Bryant does not disclose transmitting the program stream and the targeted advertisements selected for the first subgroup to the first subgroup such that "the first subgroup does not receive targeted advertisements corresponding to any other subgroup." Instead, Bryant teaches a system that distributes a single composite program, containing a base program segment and a fill program segment. Multiple targeted advertisements are included in each fill program segment (see Figs. 3, 6, and 8 of Bryant), with each advertisement in a particular fill segment being selected for a different target audience. Fig. 8 of Bryant demonstrates distribution of a single composite program containing multiple sets of targeted advertisements within a single fill segment. In Fig. 8, the same composite program is delivered to different subscriber groups, where the set-top box selects the appropriate advertisement within the fill segment for presentation to the subscriber. In other words, the households containing STB 832 and STB 833, both receive the same composite program containing multiple sets of targeted advertisements selected for different subscribers from the street box or cable head-end. The set-top box determines which of the received targeted advertisements to display. Thus, Bryant does not disclose that "the first subgroup does not receive targeted advertisements

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corresponding to any other subgroup." Since Bryant does not teach or suggest all elements of independent claim 117, independent claim 117 is believed to be allowable. Claims 118-119, 122-124, 127-129, 131-133, 135-138, 143-144, and 146-148 are allowable at least by their dependency on independent claim 117.

Independent claim 121 recites "wherein the first subgroup does not receive targeted advertisements corresponding to any other subgroup." For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that Bryant does not teach or suggest the features of independent claim 121. Accordingly, independent claim 121 is believed to be allowable over Bryant.

Independent claim 149 recites "wherein the targeted advertisements in the first presentation stream correspond to the first subgroup." For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that Bryant does not teach or suggest the features of independent claim 149. Accordingly, independent claim 149 is believed to be allowable over Bryant. Dependent claims 150, 154-156, 159-160, and 162-164 are allowable at least by their dependency on independent claim 149.

Independent claim 153 recites "wherein the targeted advertisements in the first presentation stream correspond only to the first subgroup." For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that Bryant does not teach or suggest the features of independent claim 153. Accordingly, independent claim 153 is believed to be allowable over Bryant.

Independent claim 196 recites "wherein the first presentation stream includes targeted advertisements only from the first set of targeted advertisements", and "wherein the second presentation stream includes targeted advertisements only from the second set of targeted advertisements." For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that Bryant does not teach or suggest the features of independent claim 196. In addition, claim 196 recites a "signal containing the requested content material." Bryant teaches a system of broadcasting

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composite programs using existing broadcast networks which do not provide two-way communication on the network as would be required for a video-on-demand system where program material can be requested over the network by a subscriber. Thus, Bryant does not teach this feature of Applicants' invention. Accordingly, independent claim 196 is believed to be allowable over Bryant.

Reconsideration and withdrawal of the Examiner's rejection of claims 117-119, 121-124, 127-129, 131-133, 135-138, 143-144, 146-150, 153-156, 159-160, 162-164 and 196 are respectfully requested.

Claim Rejections – 35 U.S.C. §103(a)

The Examiner has rejected claims 130, 134, 139-142, 145, 161, 172-173, 177, 192, 194, and 198 under 35 U.S.C. §103(a) as being unpatentable over Bryant. The Examiner contends that Bryant in combination with common knowledge in the art teaches all elements of these claims. Applicants respectfully traverse this rejection.

For the reasons discussed above, independent claims 117 and 149 are allowable over Bryant. Dependent claims 130, 134, 139, 140 are allowable at least by their dependency on independent claim 117. Dependent claim 161 is allowable at least by its dependency on independent claim 149.

With respect to dependent claims 139 and 140, the Examiner has taken Official Notice (see page 8 of the Office Action) that it was "well known in the art to have a first digital signal sent over a first channel and a second digital signal sent over a second channel so as to conserve bandwidth." However, Applicants disagree that there are "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art," as required by M.P.E.P. §2144.03, which would support an Examiner's finding of Official Notice.

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To the extent that the Examiner's taking of Official Notice may be applied to any of the amended claims, Applicants respectfully traverse the Examiner's taking of Official Notice, and respectfully request that the Examiner support the taking of Official Notice by producing a relevant reference that shows/teaches having a first digital signal sent over a first channel and a second digital signal sent over a second channel so as to conserve bandwidth, and that the Examiner identify a specific teaching in the reference to support a combination with Bryant.

Independent claim 141 recites (emphasis added) "transmitting the program stream and only the targeted advertisements selected for the first subgroup to the first subgroup." For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that Bryant does not teach or suggest the features of independent claim 141. Accordingly, independent claim 141 is believed to be allowable over Bryant.

Independent claims 142 and 145 each recite "wherein the targeted advertisements transmitted to the first subgroup include only targeted advertisements corresponding to the first subgroup." For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that Bryant does not teach or suggest the features of independent claims 142 and 145. Accordingly, independent claims 142 and 145 are believed to be allowable over Bryant.

Independent claim 172 recites "wherein the first subgroup receives targeted advertisements corresponding only to the first subgroup" and "wherein the second subgroup receives targeted advertisements corresponding only to the second subgroup." For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that Bryant does not teach or suggest the features of independent claim 172. Accordingly, independent claim 172 is believed to be allowable over Bryant.

Independent claim 192 recites "wherein the first subgroup does not receive targeted advertisements corresponding to any other subgroup" and "wherein the second subgroup does not receive targeted advertisements corresponding to any other subgroup." In addition, claim 192 recites (emphasis added) "signal containing the requested content

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material." For the same reasons discussed above with respect to independent claim 196, Applicants respectfully submit that Bryant does not teach or suggest the features of independent claim 192. Accordingly, independent claim 192 is believed to be allowable over Bryant.

With respect to independent claims 141, 142, 145, 172, and 192, the Examiner has taken Official Notice (see page 7 of the Office Action) that it was "well known in the art to use the Internet so as to give the user an alternative way to receive the video broadcasting signals." However, Applicants disagree that there are "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art," as required by M.P.E.P. §2144.03, which would support an Examiner's finding of Official Notice.

To the extent that the Examiner's taking of Official Notice may be applied to any of the amended claims, Applicants respectfully traverse the Examiner's taking of Official Notice, and respectfully request that the Examiner support the taking of Official Notice by producing a relevant reference that shows/teaches using the Internet so as to give the user an alternative way to receive the video broadcasting signals, and that the Examiner identify a specific teaching in the reference to support a combination with Bryant.

For the same reasons discussed above, Applicants respectfully submit that Bryant does not teach or suggest the features of independent claims 165, 175, 182, and 197. Accordingly, independent claims 165, 175, 182, and 197 are believed to be allowable over Bryant. Claims 173, 177, 194, and 198 are allowable at least by their dependency on independent claims 165, 175, 182, and 197, respectively.

With respect to dependent claims 173, 177, 194, and 198, the Examiner has taken Official Notice (see page 8 of the Office Action) that it was "well known in the art to use an advertisement server so as to allow the target advertisement to be easily updated." However, Applicants disagree that there are "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art," as

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required by M.P.E.P. §2144.03, which would support an Examiner's finding of Official Notice.

To the extent that the Examiner's taking of Official Notice may be applied to any of the amended claims, Applicants respectfully traverse the Examiner's taking of Official Notice, and respectfully request that the Examiner support the taking of Official Notice by producing a relevant reference that shows/teaches using an advertisement server so as to allow the target advertisement to be easily updated, and that the Examiner identify a specific teaching in the reference to support a combination with Bryant.

Reconsideration and withdrawal of the Examiner's rejection of claims 130, 134, 139-142, 145, 161, 172-173, 177, 192, 194, and 198 are respectfully requested

The Examiner has rejected claims 120, 152-153, 165-171, 175-176, 178-191, 193, 195, 197-199 under 35 U.S.C. §103(a) as being unpatentable over Bryant in view of U.S. Patent No. 6,078,954 to Lakey ("Lakey"). The examiner contends that Bryant in combination with Lakey teaches all elements of these claims. In particular, the Examiner acknowledges that Bryant does not teach or suggest the use of multicasting, but contends that Lakey teaches this missing element, and concludes that it would have been obvious to combine the teachings of Lakey with those of Bryant to result in Applicants' claimed invention. Applicants respectfully traverse this rejection.

When making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. The Examiner can satisfy this burden only by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1998). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The mere fact that the prior art could be modified in the manner proposed by the Examiner, does not make the modification obvious unless the prior art

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suggests the desirability of the modification. *See Ex Parte Dussaud*, 7 U.S.P.Q.2d 1818, 1820 (Bd.Pat.App & Interf. 1988).

Neither Bryant nor Lakey explicitly or inherently contains a suggestion to make such a combination, nor has the Examiner pointed to any such objective teaching. Furthermore, one skilled in the art would not have been motivated to combine Lakey with Bryant, as the Examiner suggests. More specifically, Bryant discloses a system for delivery of composite programs to targeted audiences, while Lakey discloses implementing a multicast protocol on a network. The system of Lakey inherently contains two-way (bi-directional) communication between a client and server. For example, "when a client is activated, it notifies the server of its active status" (column 2, lines 12-13). Bryant however states "interactive program distribution requires two-way (duplex) communication on the network. Duplex communication ... generally uses more complex and expensive equipment...It is desired to precisely broadcast program signals...without unduly increasing the complexity of extant broadcast networks" (column 2, lines 5-13). Accordingly, there would be no motivation for one of ordinary skill in the art to look to Lakey to solve a problem not present in Bryant, nor to add unnecessary elements not required by Bryant. In view of the foregoing, Applicants respectfully submit that the combination of Bryant and Lakey is improper.

Additionally, the prior art references, when combined, must teach or suggest all of the claim limitations. *See* MPEP 2143. However, even if one were to combine the teachings of Bryant and Lakey, the resulting system would still not teach or suggest a system as claimed by Applicants. The arguments discussed above with respect to independent claim 117 are applicable to the combination of Bryant and Lakey, since Lakey does not teach or suggest the features missing from Bryant.

For the reasons discussed above, independent claim 117 is allowable over Bryant. Claims 120 and 152 are allowable at least by their dependency on independent claim 117.

Independent claim 153 recites "wherein the targeted advertisements in the first presentation stream correspond only to the first subgroup." Even if one were to combine

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the teachings of Bryant and Lakey, for the same reasons discussed above, Applicants respectfully submit that Bryant, and therefore the combination, does not teach or suggest all the features of independent claim 153. Since the combination of Bryant and Lakey is improper, and/or since such combination does not teach or suggest all elements of claim 153, independent claim 153 is believed to be allowable over the Examiner's combination of Bryant and Lakey.

Independent claims 165 and 175 each recite "the first subgroup does not receive targeted advertisements corresponding to any other subgroup" and "the second subgroup does not receive targeted advertisements corresponding to any other subgroup." For the same reason discussed above with respect to independent claim 153, Applicants respectfully submit that the combination of Bryant and Lakey does not teach or suggest the features of independent claims 165 and 175. Since the combination of Bryant and Lakey is improper, and/or since such combination does not teach or suggest all elements of claims 165 and 175, independent claims 165 and 175 are believed to be allowable over the Examiner's combination of Bryant and Lakey. Dependent claims 166-171, 173 are allowable at least by their dependency on independent claim 165. Dependent claims 176-177, and 179-181 are allowable at least by their dependency on independent claim 175

Independent claim 178 recites "the first subgroup receives targeted advertisements corresponding only to the first subgroup" and "the second subgroup receives targeted advertisements corresponding only to the second subgroup." For the same reason discussed above with respect to independent claim 153, Applicants respectfully submit that the combination of Bryant and Lakey does not teach or suggest the features of independent claim 178. Since the combination of Bryant and Lakey is improper, and/or since such combination does not teach or suggest all elements of claim 178, independent claim 178 is believed to be allowable over the Examiner's combination of Bryant and Lakey.

With respect to independent claim 178, the Examiner has taken Official Notice (see page 10 of the Office Action) that it was "well known in the art to implement channels using the DOCSIS standard so as to allow interoperability." However,

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Applicants disagree that there are "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art," as required by M.P.E.P. §2144.03, which would support an Examiner's finding of Official Notice.

To the extent that the Examiner's taking of Official Notice may be applied to any of the amended claims, Applicants respectfully traverse the Examiner's taking of Official Notice, and respectfully request that the Examiner support the taking of Official Notice by producing a relevant reference that shows/teaches implementing channels using the DOCSIS standard so as to allow interoperability, and that the Examiner identify a specific teaching in the reference to support a combination with Bryant.

Independent claim 182 recites "wherein the first presentation stream contains advertisements only included in the first set of targeted advertisements" and "wherein the second presentation stream contains advertisements only included in the second set of targeted advertisements." In addition, claim 182 recites (emphasis added) "signal containing the requested content material," For the same reasons discussed above with respect to independent claim 196, Applicants respectfully submit that Bryant, and therefore the combination, does not teach or suggest the features of independent claim 182. Since the combination of Bryant and Lakey is improper, and/or since such combination does not teach or suggest all elements of claim 182, independent claim 182 is believed to be allowable over the Examiner's combination of Bryant and Lakey. Dependent claims 183-191, 193-195 are allowable at least by their dependency on independent claim 182.

Independent claim 197 recites "wherein the first subgroup does not receive targeted advertisements corresponding to any other subgroup" and "wherein the second subgroup does not receive targeted advertisements corresponding to any other subgroup." For the same reason discussed above with respect to independent claim 153, Applicants respectfully submit that the combination of Bryant and Lakey does not teach or suggest the features of independent claim 197. Since the combination of Bryant and Lakey is improper, and/or since such combination does not teach or suggest all elements of claim 197, independent claim 197 is believed to be allowable over the Examiner's combination

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of Bryant and Lakey. Dependent claims 198-199 are allowable at least by their dependency on independent claim 182.

The Examiner has rejected claims 125-126, and 157-158 under 35 U.S.C. §103(a) as being unpatentable over Bryant in view of U.S. Patent No. 5,446,919 to Wilkins ("Wilkins"). The examiner contends that Bryant in combination with Wilkins teaches all elements of these claims. In particular, the Examiner acknowledges that Bryant does not teach or suggest matching viewers to advertisements based on psychographic information, but contends that Wilkins teaches this missing element, and concludes that it would have been obvious to combine the teachings of Wilkins with those of Bryant to result in Applicants' claimed invention. Applicants respectfully traverse this rejection.

For the reasons discussed above, independent claims 117 and 149 are allowable over Bryant since Wilkins does not teach the deficiencies of Bryant, independent claims 117 and 149 are allowable over the combination of Bryant and Wilkins. Dependent claims 125-126, and 157-158 are allowable at least by their dependency on independent claims 117 and 149, respectively.

The Examiner has rejected claim 174 under 35 U.S.C. §103(a) as being unpatentable over Bryant in view of U.S. Patent No. 6,434,621 to Pezzillo ("Pezzillo"). The examiner contends that Bryant in combination with Pezzillo teaches all elements of this claim. In particular, the Examiner acknowledges that Bryant does not teach or suggest Internet radio, but contends that Pezzillo teaches this missing element, and concludes that it would have been obvious to combine the teachings of Pezzillo with those of Bryant to result in Applicants' claimed invention. Applicants respectfully traverse this rejection.

Independent claim 174 recites "wherein the first subgroup does not receive targeted advertisements corresponding to any other subgroup" and "wherein the second subgroup does not receive targeted advertisements corresponding to any other subgroup." Even if one were to combine the teachings of Bryant and Pezzillo, the resulting system would still not teach or suggest a system as claimed by Applicants. The arguments

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discussed above with respect to independent claim 117 are applicable to the combination of Bryant and Pezzillo, since Pezzillo does not teach the missing features of Bryant when Bryant is considered alone. Applicants respectfully submit that Bryant, and therefore the combination, does not teach or suggest the features of independent claim 174.

Accordingly, independent claim 174 is believed to be allowable over the combination of Bryant and Pezzillo.

Applicants note that although all claims stand rejected by the examiner on the Office Action Summary, the Examiner does not include any mention of claim 151 in the Detailed Action section. Accordingly, since independent claim 149 is believed to be allowable over Bryant for the reasons discussed above, dependent claim 151 is allowable at least by its dependency on independent claim 149.

Reconsideration and withdrawal of the Examiner's rejection of claims 120, 125-126, 130, 134, 139-142, 145, 151-153, 157-158, 161, 165-195, 197-199 are respectfully requested.

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 117-199, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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